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JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER SHANG, ANNAN Q	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/039,855

**Applicant(s)**

BILLOCK ET AL.

**Examiner**

ANNAN Q. SHANG

**Art Unit**

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/08/09 has been entered.

### ***Response to Arguments***

2 With respect to the rejection of the last office action mailed 01/08/09, Applicant amends some claims, discusses the claimed invention and the prior art of record and further argues that the prior art of record does not teach the claims limitations, that "...Hendricks does not disclose a method of operating a VOD service..." that "...Hendricks does not disclose or suggest in any way that its television program delivery system is accessible to non-subscribers..."(see page 12+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes Applicant's arguments, however, **Hendricks** reference figures 1-5, discloses a television program delivery system and further discloses a method of operating a video-on-demand (VOD, movies or programs on demand (see [0282], [0284] and [0288])) service comprising at least one interactive channel coupled to a viewing station (ST- 220), the service accessible to

subscribers and non-subscribers of the service, the service providing video programs, segments of the video programs, and a list of at least some of the video programs, the method comprising: Hendricks discloses a Transmitting station (OC/HE 202/208) which transmits a first signal to the viewing station acknowledging access of the service; transmitting the list (Catalog data and Menu) to the viewing station, STT-220 (figs.1-5, 14, 15, page 5, [0122-0131], [0280-0281] and [0284-0286]), and receives (STT-220) a second signal (subscriber interactive requests, video program classification information associated with a subscriber identifier) from the viewing station indicating a selection of one of the segments of the video programs, where subscriber, via an input device (RC-900) interacts to Menu, which includes preview video products or trailers, to order any available video product where the OC/HE 202/208 stores the received identifier of the receiving station, compares the identifiers to a list of identifiers corresponding to the STTS-220 and process the various request to a particular STT-220 ([0186], [0264], [0280-0281] and [0284-0286]). OC/HE 202/208, transmits one of the segments to the viewing station indicating one of the segments to the viewing station when the second signal indicates a selection of the one segment by either a subscriber or a subscriber not currently subscribe to program(s)/channel(s) (refer to as "non-subscriber") ([0186], [0264], [0280-0281] and [0284-0286]) and prevents transmission of one of the video programs to the viewing station when the second signal indicates a selection of the one video program by one of the non-subscribers and transmitting one of the video programs to the viewing station when the second signal indicates a selection of the one video program by one of the subscribers (figs.15-18, 30-51, 112, 114, page 19, [0284-

0294], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]). Hendricks clearly illustrates in figures 1-5, 14-18+, a delivery system and method where a Head end (OC/HE 202/208) stores programs and transmits a list (Catalog data and Menu) to the viewing station (STT-220) and allows subscriber(s) to interact to request video program(s)/channel(s) (instant ordering and subscription packages of program(s)/channel(s)) (figs.15+). Figures 30-32 illustrates where upon receiving on-subscriber request, the system subscribes the subscriber and displays a message "Thank you for subscribing! You are joining the channel in progress." (fig.32). Furthermore in fig.33, if the subscriber is already subscribe to a program/channel, the system displays a message "You are a current subscriber. Thank you! ...joining now in progress" Hendricks further illustrates in figs.35-38 and 111-114, messages/images to the subscriber that enables non-subscribers of program(s)/channel(s) to subscribe to a program(s)/channel(s) (page 19, [0280-0286] page 19, [0284-0294], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]). Hendricks is silent as to specific use of the phrase "non-subscriber" in the disclosure. However, disclosure clearly discloses a system which permits subscriber(s) to instantly subscribe to non-subscribe program(s)/channel(s). Hence Applicant's amended/unamended claims do not overcome the prior art of record as discussed below. **This office action is non-final.**

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hendricks (2005/0157217)**.

As to claims 1-3, note the **Hendricks** reference figures 1-5, discloses a television program delivery system and further discloses a method of operating a video-on-demand (VOD, movies or programs on demand (see [0282], [0284] and [0288])) service comprising at least one interactive channel coupled to a viewing station (ST- 220), the service accessible to subscribers and non-subscribers of the service, the service providing video programs, segments of the video programs, and a list of at least some of the video programs, the method comprising:

Transmitting (OC/HE 202/208) on-demand first signal to the viewing station acknowledging access of the service; transmitting the list on demand (Catalog data and Menu) to the viewing station, STT-220 (figs.1-5, 14, 15, page 5, [0122-0131], [0280-0281] and [0284-0286]);

Receiving (STT-220) a second signal (subscriber interactive requests, video program classification information associated with a subscriber identifier) from the viewing station indicating a selection of one of the segments of the video programs, note that the subscriber, via an input device (RC-900) interacts to Menu, which includes preview video products or trailers, to order any available video product where the OC/HE 202/208 stores the received identifier of the receiving station, compares the

identifiers to a list of identifiers corresponding to the STTS-220 and process the various request to a particular STT-220 ([0186], [0264], [0280-0281] and [0284-0286]).

Transmitting (OC/HE 202/208) one of the segments to the viewing station indicating one of the segments to the viewing station when the second signal indicates a selection of the one segment by either a subscriber or a subscriber not currently subscribe to program(s)/channel(s) (refer to as "non-subscriber") (0186), [0264], [0280-0281] and [0284-0286]);

Preventing transmission of one of the video programs to the viewing station when the second signal indicates a selection of the one video program by one of the non-subscribers and transmitting one of the video programs to the viewing station when the second signal indicates a selection of the one video program by one of the subscribers (figs.15-18, 30-51, 112, 114, page 19, [0284-0294], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]).

Hendricks illustrates in figures 1-5, 14-18+, an on-demand delivery system and method where a Head end (OC/HE 202/208) which stores programs and transmits a list (Catalog data and Menu) to the viewing station (STT-220) and allows subscriber(s) to interact to request on-demand video program(s)/channel(s) (instant ordering and subscription packages of program(s)/channel(s)) (VOD, movies or programs on demand, see [0282], [0284] and [0288], figs.15+). Figures 30-32 illustrates where upon receiving on-subscriber request, the system subscribes the subscriber and displays a message "Thank you for subscribing! You are joining the channel in progress." (fig.32). Furthermore in fig.33, if the subscriber is already subscribe to a program/channel, the

system displays a message "You are a current subscriber. Thank you! ...joining now in progress" Hendricks further illustrates in figs.35-38 and 111-114, messages/images to the subscriber that enables non-subscribers of program(s)/channel(s) to subscribe to a program(s)/channel(s) (page 19, [0280-0286] page 19, [0284-0294], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]).

Hendricks is silent as to specific use of the phrase "non-subscriber" in the disclosure.

However, disclosure clearly discloses a system which permits subscriber(s) to instantly subscribe to non-subscribe program(s)/channel(s).

Hence it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Hendricks with the phrase "non-subscriber(s)" to distinguish between subscribers and non-subscribers and permit non-subscriber(s) to instantly subscribe to program(s)/channel(s) as taught by Hendricks.

As to claim 4-6, Hendricks further discloses where the video programs and the segments comprise video and audio portions, at least one movie and one TV program (col.3, lines 32-49 and col.4, lines 13-46).

As to claim 7, the claimed "A video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claims 7-8, **Hendricks** further discloses in figures 1-5, discloses a video-on-demand (VOD) service comprising:



A telecasting facility (OC/HE 202/208) operative to provide video programs, previews of the video programs, and at least one list of at least some of the video programs and operative to receive selections of the previews and the video programs, the facility (figs.1-5, 14, 15, page 5, [0122-0131], [0280-0281] and [0284-0286]) comprising:

A multiple processor computer (Processors OC/HE 202/208 "first computer") of that allows the list and the previews comprising summary of content of video, audio, full-motion to be transmitted on-demand (VOD, movies or programs on demand, see [0282], [0284] and [0288]) to subscribers and non-subscribers of the service and that allows the video programs to be transmitted to only the subscribers (figs.15-18, 30-51, 112, 114, page 19, [0122-0131], [0280-0281], [0284-0286], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]).

A mass storage system coupled to the computer (figs.1 and 4a), the mass storage system storing the list and the previews, and transmitting station coupled to the computer, the transmitting station operative to transmit the video programs, the previews, and the list to viewing station (STT-220, which includes a display and a computer "second computer) and operative to receive the selections; and communication medium comprises a plurality of channels coupled to the transmitting station over which the video programs, the previews, and the list are transmitted from the telecasting facility and over which the selections are transmitted to the telecasting facility (figs.1-5, 14-18, 30-51, page 5, [0122-0131], [0280-0281], [0284-0286], [0296-0302], [0316-0317] and [0330-0336]).

Hendricks illustrates in figures 1-5, 14-18+, a delivery system and method where a Head end (OC/HE 202/208) which stores programs and transmits a list (Catalog data and Menu) to the viewing station (STT-220) and allows subscriber(s) to interact to request video program(s)/channel(s) (instant ordering and subscription packages of program(s)/channel(s)) (figs.15+). Figures 30-32 illustrates where upon receiving on-subscriber request, the system subscribes the subscriber and displays a message "Thank you for subscribing! You are joining the channel in progress." (fig.32). Furthermore in fig.33, if the subscriber is already subscribe to a program/channel, the system displays a message "You are a current subscriber. Thank you! ...joining now in progress" Hendricks further illustrates in figs.35-38 and 111-114, messages/images to the subscriber that enables non-subscribers of program(s)/channel(s) to subscribe to a program(s)/channel(s) (page 19, [0280-0286] page 19, [0284-0294], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]).

Hendricks is silent as to specific use of the phrase "non-subscriber" in the disclosure.

However, disclosure clearly discloses a system which permits subscriber(s) to instantly subscribe to non-subscribe program(s)/channel(s).

Hence it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Hendricks with the phrase "non-subscriber(s)" to distinguish between subscribers and non-subscribers and permit non-subscriber(s) to instantly subscribe to program(s)/channel(s) as taught by Hendricks.

As to claim 9, Hendricks further discloses where the communication medium is selected from the group consisting of coaxial cable the fiber optic cable (page 5, [0125-0126]).

As to claim 10, **Hendricks** further discloses claimed "A video-on-demand service comprising..." which is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3. Hendricks further discloses displaying on the display the list to an offer for the non-subscribers to become a subscriber substantially immediately after the non-subscriber selects on of the video programs for display and receiving and acceptance of the offer to be a subscriber, establishing non-subscriber as a subscriber substantially immediately after the receiving and allowing the video programs selected by the non-subscriber to be displayed on the display substantially immediately after the establishing "...displaying on said display one of said segments received in response to selection of said segment by one of said non-subscribers (figs.15-18, 30-51, 112, 114, page 19, [0122-0131], [0280-0281], [0284-0286], [0296-0302], [0316-0317], [0330-0336] and [0353-0358]).

As to claims 11-13, Hendricks further discloses where the display is a television monitor, computer and provides audio (figs.2, 3d, [0133-0136], [0139]).

As to claim 14, **Hendricks** further discloses video-on-demand service comprising..." which is composed of the same structural elements that were discussed with respect to the rejection of claim 7.

Claim 15 is met as previously discussed with respect to claim 10.

As to claim 16, the claimed "A method of operating a video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claims 17-18, Hendricks further discloses where the classification information causes those video programs that contain violence to be excluded from the generated list and only those programs that are suitable for children to be included on the generated list ([0116], [0205], [0263], [0281], [0296] and [0346]).

As to claims 19-20, the claimed "A method of operating a video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claim 21, the claimed "A video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claim 7.

Claims 22-25 are met as previously discussed with respect to claim 7.

As to claims 26-29, Hendricks further discloses where a plurality of windows for textual, previews, etc. where anyone of the screens is displayable immediately after display of any other one of the screens, where one of the screens is selectable from one of any one the screens and where another one of the lists, the segments and the textual descriptions is displayable on the respective screens immediately after a respective one of the lists, segments and the textual descriptions is displayed on the respective screens (figs.18-50+, [00295-0356]).

As to claim 30-31, Hendricks further discloses where the telecasting facility is further operative to transmit textual descriptions of the video programs, the User display is further operative to receive the textual descriptions and the interactive interface comprises a list mode actuator that when actuated causes one of the lists to be displayed on the display, preview mode actuator that when actuated causes one of the previews to be displayed on the display and information mode actuator that when actuated causes one of the textual descriptions to be displayed on the display and a remote control unit (figs.11-12, 18-50+ and [00295-0356]).

As to claim 32-35, Hendricks further discloses where the video programs are organized into categories and the interactive interface comprises: a previous-category actuator that when actuated displays on the display a preceding category of video programs in a sequence of categories; a next-category actuator that when actuated displays on the display the next category of video programs in the sequence, a previous-program actuator that when actuated causes a displayed one of the list to scroll in a first direction on the display, etc., (figs.11-12, 18-50+ and [00295-0356]).

As to claims 36-38, the claimed "A method of operating a video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, **call 800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Annan Q Shang/

Primary Examiner, Art Unit 2424

**Annan Q. Shang**